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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,045	01/22/2002	Timothy G. Tyler	LOG-03-PUSA	1482

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,045

Applicant(s)

TYLER ET AL.

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "powder" is indefinite because it does not describe the component in terms of what it is. "Powder" is only the form that a substance takes. It may be a face powder, gunpowder, talcum powder, a powdered drug. By stating that a powder is applied, applicant is not stating what is applied. Tugwell, US 4,037,008 col 4 lines 44 et seq, defines a plastisol as resin particles dispersed in a plasticizer. Are not the resin particles themselves a powder since they are in the form of particles? Accordingly, we may assume that whenever a plastisol composition is applied to a transfer sheet, said plastisol incorporates a powder.

Response to Arguments

The above rejection is maintained because applicant's arguments are not persuasive. The term powder does not define the additive used. It merely defines the form of the additive. Until the content of the powder is defined chemically the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sammis, US 6,143,115 in view of Hurnik et al. US 4,623,686.

Sammis teaches formation of a transfer sheet with abrasive particles imbedded therein. (Title) The transfer material comprises a single, independent, homogeneous and transparent layer of thermoplastic material such as a plastisol which liquefies upon heating during the heat transfer process. Col 3 lines 62-65. Before the transfer material has fully congealed the abrasive particles are partially embedded therein. The transfer material is applied to the transfer sheet by passing it through a screen. Col 4 lines 1-10. The abrasive particles are also adhesive in nature when activated by heat. Said abrasive particles may be nylon, which is a polyamide, reading on the copolyamide as claimed. Additionally, since the abrasive particles have adhesive properties, said particles (powder) adhere to the surface. Col 4 lines 12-28. Since the abrasive particles may be considered a powder, this disclosure teaches applying powder to the plastisol ink layer and then heating as claimed. The patent differs from the instant claims in not claiming that the ink comprises aromatic polyisocyanates.

Hurnik et al. disclose the formation of plastisol compositions which comprise a composition comprising aromatic polyisocyanates. Hurnik's plastisols have excellent storage stability and improve the bonding of the plastisol to substrates such as plastics, foils and textile sheet products. See Hurnik col 1 lines 51-68, and the teaching of aromatic polyisocyanates at col 4 lines 52 et seq. It would have been obvious to the

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skilled artisan to use the plastisol composition comprising the polyisocyanate as disclosed by Hurnik et al. as the ink in patentee's process for the improved benefits as taught by Hurnik et al., that is, excellent adhesive properties and storage stability. Noting example 5 in col 19, the proportions of plastisol to polysiocyanate are more than 2 to 1; the curing temperature is at least about 100 degrees Fahrenheit in a circulating oven, equivalent to applicant's curing tunnel. Regarding the limitations of claim 19 and its dependent claims and claim 42 and its dependent claims, it is well known that more than one ink may be applied to the same transfer paper to form a multicolor image.

Response to Arguments

Applicant's arguments filed 9/17/03 regarding the aboe 103 rejection of claims 1-50 have been fully considered but they are not persuasive. Applicant argues that the materials used by Sammis, as noted in col 4 lines 29-30 require that they be heated to a temperature range which is much higher than the temperature range that applicant has added to the independent claims, that is, 220 to 400 degrees Fahrenheit. Applicant is directed to column 4 last paragraph of Sammis, which discloses the temperature range to which the transfer is heated in the process of heating the transfer layer with the abrasive particles. Beginning on line 61, Sammis states, "Ideally, the heating process heats the adhesive-abrasive particles to a temperature range of 118° C. to 143° C. which is 245° F. to 290° F." This is entirely within the range claimed. Accordingly the rejection is maintained.

The following is a new grounds of rejection.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has added the limitation, "wherein said ink compound and powder are such that said image can be imprinted on said soft surface with heat applied to said heat transfer paper at a temperature in the range of 220 to 400 degrees Fahrenheit for up to 15 seconds." There is no basis in the originally filed specification for that limitation. Accordingly said limitation is new matter.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret Einsmann
Primary Examiner
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November 20, 2003